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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,090	02/02/2004	Roberto Semeia	KAR 001	9265
39232	7590	08/17/2006	EXAMINER	
Serafini Associates 7660 FAY AVE. STE H378 LA JOLLA, CA 92037			RIVELL, JOHN A	
			ART UNIT	PAPER NUMBER
			3753	
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/770,090	Applicant(s) SEMEIA, ROBERTO	
	Examiner John Rivell	Art Unit 3753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/6/06 (election).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 3, 11-38 and 48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 7, 39, 40, 44 and 45 is/are rejected.
- 7) ☒ Claim(s) 5, 6, 8-10, 41-43, 46 and 47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's election with traverse of the species of Group A, figure 12A, claims 1-10, 14-24 and 37-47 in the reply filed on June 6, 2006 is acknowledged. The traversal is on the ground(s) that:

"One embodiment of Applicant's invention is illustrated in Figs. 4-5, which depict a blade with square edges that is contacted against a shutter disk. One skilled in the art will appreciate that the same blade can be embodied in equivalent designs, from the jagged edge design of Fig. 1 2A, to the ribbed edge design of Fig. 1 3A, to the multi-columnar design of Fig. 1 4A, and so on. Therefore, the above mentioned designs are simply embodiments of a single invention, that is, a system for constraining the shutter disk of a valve so to avoid leaks.

[and that]

Applicant has clearly indicated, e.g. at paragraphs (00291-E0034) of the application, that the above mentioned designs are all embodiments of a single invention."

This is not found persuasive because applicant's arguments appear to agree with the Examiner that this application contained, and still contains, claims to patentably distinct species of the claimed invention.

Additionally, applicant does not convincingly argue that this application did not, and does not, contain claims to patentably distinct species nor does applicant explicitly identify where it is shown, or explicitly state, that the claimed species are not patentably distinct.

The requirement is still deemed proper and is therefore made FINAL.

Accordingly, in view of applicants claim listing, claims 11-13, 25-36 and 48 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on June 6, 2006.

Of those claims listed as being readable on the elected species, it is noted that, as presented in the response of June 6, 2006, claim 6 is identified by applicant as being "withdrawn". Given that applicant elected the species of figure 12A, and that the species of Figure 12A explicitly illustrates the "second means (being) in discontinuous contact with the line that is secant to the shutter disk", as recited in claim 6, claim 6 is being examined.

Additionally, of those claims listed as being readable on the elected species, claims 3, 14-16, 17-24 and 37-38 are not readable on the elected species as follows.

Regarding claim 3, the claim requires the "second means... (to) retain also a second portion of said shutter disk substantially in contact with said valve seat along parts of two different lines (emphasis added) that are secant to said shutter disk".

Lines of contact "along parts of two different lines" as required by the claim is not illustrated in elected figure 12A but rather, for example, in non elected figures, 13A, 14A, 17A, etc. Accordingly, claim 3 is held to be withdrawn.

Regarding claim 14, the claim requires "the second means consist essentially of a row of secondary clamping pins, said secondary clamping pins extending from the shutter disk and said secondary clamping pins being engaged in corresponding openings on the valve seat".

"Secondary clamping pins" are not illustrated in elected figure 12A and on review, are not illustrated at all in the figures. Accordingly claim 14 is held withdrawn. Claims 15 and 16, being directly dependent on claim 14 are thus also held withdrawn.

Regarding claim 17, the claim requires "...second means for retaining two portions of said shutter disk substantially in contact with said valve seat during ejection of liquid or gas through said valve, said portion of said shutter disk being situated along two lines that are secant to said shutter disk."

"Two lines" of contact secant to the valve disk, as required by the claim is not illustrated in elected figure 12A but rather, for example, in non elected figures, 13A, 14A, 17A, etc. Accordingly, claim 17 is held to be withdrawn. Claims 18-24 and 37, 38, being ultimately dependent on claim 17 are thus also held withdrawn.

Accordingly, claims 3, 11-38 and 48 are held as withdrawn as noted above.

An action on the merits of claims 1, 2, 4-10 and 39-47 is as follows.

Figures 1-3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "peripheral extension lobes" of claim 2, the "flattening of the case wall" housing the membrane of claim 45 and any other feature of the elected claims that may have been missed by the Examiner, and all the features of any currently withdrawn claim which may survive prosecution must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Additionally, the drawings are objected to as generally failing the requirements of 37 CFR 1.84 as the drawings appear to be informal.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in

reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 44 and 45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, the specification, as originally filed, fails to provide a written description of any "open head sections... oriented at 90 degrees from the longitudinal axis of said mouthpiece" as recited in claim 44.

Additionally, the specification, as originally filed, fails to provide a written description of any "flattening of the case wall" containing the valve membrane as recited in claim 45.

A simple, but useful, corollary to remember is that if it is claimed, it must be disclosed in the written portion of the specification, under 35 USC §112, and shown in the drawings, under 37 CFR 1.83.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4 and 7 are rejected under 35 U.S.C. §102 (b) as being anticipated by Katz.

The patent to Katz discloses a "membrane valve comprising: a valve seat(108) having a continuous surface and one or two openings (104); a shutter disk (102) of flexible material surrounding said openings and having a peripheral sealing lip (at the periphery at number 109); an optional annular wall extending (radially) from said valve seat (108) and surrounding said openings (104), said optional annular wall creating one or more depressions around said openings (104), said optional annular wall being in sealing contact with said peripheral sealing lip (at 109) when a gas or a liquid is not

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being ejected through said openings (104, see fig. 1); first means (at the surface of nipple 103) for clamping said shutter disk (102) to said valve seat (108), said first means extending from said shutter disk (102) and being engaged with each of said openings (104) on said valve seat (108); and second means (at blade 107) for retaining one portion of said shutter disk (102) substantially in contact with said valve seat (108) during ejection of liquid or gas through said valve, said portion of said shutter disk being situated along a line that is secant to said shutter disk (102)" as recited in claim 1.

Regarding claim 2, in Katz, "the shutter disk (102) comprises peripheral extension lobes" read as the peripheral bent section sealing with the "optional annular wall" as shown in fig. 1, as recited.

Regarding claim 4, in Katz, "the second means (blade 107) retain a portion of the shutter disk substantially in contact with the valve seat (108) along a line that is a diametrical axis of said shutter disk (103)" as recited.

Regarding claim 7, in Katz, "the first means (at nipple 103) consist essentially of one or two primary clamping pins, said primary clamping pins being equal in number to the openings (104) on the valve seat" as recited.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as disclosed at page 2, para [0007] if the instant application in view of Katz.

The prior art, as disclosed in para [0007] of the instant application discloses all the claimed features with the exception of having "second means for retaining at least one portion of said shutter disk substantially in contact with said valve seat during ejection of gas through said valve, said portion of said shutter disk being situated along a line that is secant to said shutter disk".

The patent to Katz discloses that it is known in the art to employ a blade element 107, in contact with a flexible exhaust valve 1102 of the breathing mask, the blade 107 "extending along a line that is secant to the "valve element for the purpose of decreasing the resistance to flow of the users exhaled breath thus making it easier for the user to exhale.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ in the device of the prior art as disclosed at para [0007] of the instant application, a blade element in contact with downstream side of the flexible exhaust valve for the purpose of decreasing the resistance to flow of the users exhaled breath thus making it easier for the user to exhale as recognized by Katz.

Regarding claim 40, in Katz, "the shutter disk (102) of the membrane valve is surrounded by an outflow duct (e.g. the peripheral wall of the cap 105), one wall (e.g. the radial wall) of said outflow duct consisting of a portion of the outer wall of the case (here once the cap is connected to the valve body it is read as part of the "case" of the valve) and the remaining walls (the downstream perpendicular wall of the cap 105) of said outflow duct consisting of a profiled member (forming slots 106), said outflow duct having open ends (at slots 106) to allow for the escape of the gas ejected through said membrane valve; and wherein the second means comprise a stop rib (107) extending from said central section to come substantially in contact with said shutter disk (102" as recited.

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Claims 5, 6, 8-10, 41, 42, 43, 46 and 47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 44 and 45 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Rivell whose telephone number is (571) 272-4918. The examiner can normally be reached on Mon.-Thur. from 6:30am-5:00pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Keasel can be reached on (571) 272-4929. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John Rivell

Primary Examiner
Art Unit 3753

j.r.